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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/583,414	11/17/2008	Satoshi Washio	9683/267	6637		
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BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610				BELANI, KISHIN G		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/583,414	WASHIO ET AL.	
	Examiner	Art Unit	
	KISHIN G. BELANI	2443	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 June 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-11 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 16 June 2006 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/22/06, 12/18/08, 3/16/09, 7/23/09</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statements submitted on 08/22/2006, 12/18/2008, 03/16/2009, and 07/23/2009 have been considered by the Examiner and made of record in the application file.

Claim Objections

Claims 1 and 9 are objected to because of the following informalities:

In claim 1, line 1; delete duplicate phrase “A terminal”.

In claim 9, line 7; delete duplicate word “set”.

Also, the title of the invention is broad and not descriptive of the specification. A new title is required that is clearly indicative of the invention to which the claims are directed.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6, 10 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Tamaki (U.S. Patent Application Publication # 2005/0015285 A1).

Consider **claim 1**, Tamaki shows and discloses a terminal managing method (Fig. 6 that shows a system and method for delivery of content from contents delivery server 206 to a user terminal 216 via one of a variety of public networks 208-214 by managing the content delivery time by a combination of user management server 602, network load management server 604, and reservation server 222; paragraphs 0059 and 0035-0036 describe the details of the claimed method), comprising: an opportunity data set sending step of sending, from a managing server apparatus having a storage device, an opportunity data set indicating an opportunity to send data to a mobile communication terminal having a storage device via a communication network (Fig. 5 that shows a graphical user interface 500 (an opportunity data set) sent by the reservation server 222 (part of a group of servers 602, 504, and 222 listed above

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and shown in Fig. 6, collectively acting as a management server with storage devices network load DB 402 and user log DB 404) to a user at the user terminal 216 that includes database cache memory 606 (storage device) via one of the public networks 208-214; paragraph 0058 describes the details of the reservation information 500 (an opportunity data set) received by the user terminal 216 (a mobile communication terminal) from the reservation server 222 (part of a management server), wherein opportunities to download movies and music at different prices depending on the delivery schedule of the content selected by the user);
an opportunity data set receiving step of receiving, at the mobile communication terminal, the opportunity data set sent in the opportunity data set sending step (Fig. 5; paragraph 0058 also show and disclose this step of the method);
an information data set sending step of sending, from the mobile communication terminal, an information data set indicating information relating to the mobile communication terminal to the managing server apparatus via the communication network at the opportunity indicated by the opportunity data set (Fig. 5; paragraph 0058 further show and disclose this claimed feature by showing user's selections in shaded form and by checkmarks; paragraph 0043 describes the same details); and
an information data set storing step of receiving, at the managing server apparatus, the information data set sent in the information data set sending step and storing the received information data set in the storage device (Fig. 2, reservation server 222; paragraph 0036 which discloses that the user terminal 216 sends reservation information 500 to the reservation server 222 in order to set appropriate timing for the

download 220; further disclosing that the reservation server is configured to receive reservation information 500 from different user terminals, and based on calculated user access timing and content delivery timing, the reservation server 222 determines an appropriate time for the download 220 to the user terminal 216; since Fig. 5 shows that user may select content delivery schedule that may range from months to instant delivery, it implies that the reservation server saves user's selection of delivery schedule in order to deliver the content at the specified schedule).

Consider **claim 2**, and **as applied to claim 1 above**, Tamaki shows and discloses the claimed method, wherein the managing server stores a plurality of opportunity data sets, each data set specifying differing opportunities, and sends one of the plurality of opportunity data sets to the mobile communication terminal (Fig. 5 that shows one of the opportunity data set sent by the reservation server 222 to the mobile user terminal 216 (shown in Fig. 6), listing different delivery schedules and corresponding prices for Top-3 movies and Top-10 music; paragraph 0058 describes the same details, thereby disclosing a plurality of opportunity data sets, each data set specifying differing opportunities, for other than Top-3 movies and Top-10 music listings that can be viewed by clicking on the “Down Load Reservation Menu” button shown in Fig. 5).

Consider **claim 3**, and **as applied to claim 1 above**, Tamaki shows and discloses the claimed method, wherein the opportunity indicated by the opportunity data

set specifies a prescribed operation of the mobile communication terminal (Fig. 5 that shows one of the opportunity data set sent by the reservation server 222 to the mobile user terminal 216 (shown in Fig. 6), wherein the mobile terminal user can select one of two prescribed functions by selecting appropriate button shown at the top of the menu 500 (i.e. “Down Load Reservation Menu” and “Reserve” content delivery); the user may also select to be a member by paying a monthly \$ 0.20 fee or elect to receive the content without becoming member but paying higher price for non-members).

Consider **claim 4**, and **as applied to claim 3 above**, Tamaki shows and discloses the claimed method, wherein the opportunity indicated by the opportunity data set is a time when the mobile communication terminal performs position registration (Fig. 4 that shows a method for making a delivery timing judgment 310 for downloading the content without overloading the network by monitoring the time when the user terminal 216 is in proximity to different access points (home, point A, point B, office, etc.) by registering its position with the network, and checking the delivery threshold at each of those access points at the monitored times, the details of such monitoring are recorded in the user log DB 404 and network load DB 402; paragraphs 0049-0053 further disclose the same details).

Consider **claim 6**, and **as applied to claim 3 above**, Tamaki shows and discloses the claimed method, wherein the opportunity indicated by the opportunity data set is a time when a WWW browser is terminated in the mobile communication terminal

(Fig. 12, steps 1212-312; paragraphs 0074-0076 which disclose that at the scheduled content delivery time, the reservation server 222 performs a network accessibility check 1212 to verify that the selected network is available to the user terminal 216, the reservation server then sends a wake up request 1214 to the user terminal 216 (thereby indicating that the terminal is in sleep mode with the WWW browser shut off or inactive); further disclosing that after the terminal 216 sends back a wake up reply 1216 to the reservation server, the reservation server sends a delivery request 1218 to the content delivery server 206, which in turn delivers content to terminal 216, and the user may then view or listen to the content (using WWW browser), thereby disclosing that the opportunity indicated by the opportunity data set is a time when a WWW browser is terminated in the mobile communication terminal).

Consider **claim 10**, Tamaki shows and discloses a terminal managing apparatus (Fig. 6 that shows an apparatus for managing delivery of content to a user terminal 216 via one of a variety of public networks 208-214 by managing the content delivery time by a combination of user management server 602, network load management server 604, and reservation server 222; paragraphs 0059 and 0035-0036 describe the details of the claimed apparatus), comprising:
opportunity data set sending means for sending an opportunity data set indicating an opportunity for sending data to a mobile communication terminal having a storage device via a communication network (Fig. 5 that shows a graphical user interface 500 (an opportunity data set) sent by the reservation server 222 (part of a group of servers

602, 504, and 222 listed above and shown in Fig. 6, collectively acting as a management server with storage devices network load DB 402 and user log DB 404 (further detailed in Fig. 9)) to a user at the user terminal 216 that includes database cache memory 606 (storage device) via one of the public networks 208-214; paragraph 0058 describes the details of the reservation information 500 (an opportunity data set) received by the user terminal 216 (a mobile communication terminal) from the reservation server 222 (part of a management server), wherein opportunities to download movies and music at different prices depend on the delivery schedule of the content selected by the user); and

information data storing means for receiving an information data set indicating information relating to the mobile communication terminal sent from the mobile communication terminal via the communication network and storing the received information data set in the storage device (Fig. 5 that shows user selected data from the presented menu being sent back and Fig. 9 further shows some of the characteristics of the user terminal 216 sent from the mobile communication terminal to the user management server 602 (see Fig. 6) via the communication network 207 and stored in the user data log 404 (information data storing means); paragraphs 0058, 0059, 0065 disclose the same details).

Consider **claim 11**, Tamaki shows and discloses a mobile communication terminal (Fig. 2, user terminal 216 designed for mobile communication; paragraph 0035 discloses the details of the terminal 216 used for receiving user-selected content from a

content delivery server 206 via wireless networks 212-214) comprising:
opportunity data receiving means for receiving an opportunity data set sent via a communication network from a server apparatus sending opportunity data indicating an opportunity to send data (Fig. 5 that shows a graphical user interface 500 (an opportunity data set) received by the mobile communication terminal 216 (shown in Figs 2 and 6) sent by the reservation server 222 via one of the public networks 208-214; Fig. 6 further shows a database cache memory 606 that provides means for receiving and storing received and selected menu options; paragraph 0058 describes the details of the reservation information 500 (an opportunity data set), wherein opportunities to download movies and music at different prices depend on the delivery schedule of the content selected by the user); and
information data set sending means for sending an information data set indicating information relating to the terminal to the server apparatus via the communication network at the opportunity indicated by the opportunity data set received by the opportunity data receiving means (Fig. 6, database cache memory 606 that further provides means for sending an information data set indicating information relating to the terminal 216 to the reservation server 222 via the communication network 207; and Fig. 9 that further shows some of the characteristics of the user terminal 216 sent from the mobile communication terminal to the user management server 602 (see Fig. 6) via the communication network 207 and stored in the user data log 404; paragraphs 0058, 0059, 0065 disclose the same details).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Tamaki (U.S. Patent Application Publication # 2005/0015285 A1)** in view of **Moriai (U.S. Patent Application Publication # 2007/0204182 A1)**.

Consider **claim 5**, and **as applied to claim 3 above**, Tamaki shows and discloses the claimed method, except wherein the mobile communication terminal is a foldable terminal, and the opportunity indicated by the opportunity data set is a time when the mobile communication terminal is closed.

In the same field of endeavor, Morai shows and discloses the claimed method, wherein the mobile communication terminal is a foldable terminal, and the opportunity indicated by the opportunity data set is a time when the mobile communication terminal is closed (Figs. 1-2C which show a cellular phone (foldable mobile communication terminal) with its casing in the form of a shell opened and closed; abstract which describes a detection unit that detects whether the case has been closed while download of content is occurring, then directing a power supply control unit to continue supplying power required for completing the download, thereby disclosing that the opportunity indicated by the opportunity data set is a time when the mobile communication terminal is closed).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to continue to provide the opportunity for the duration of the download time, even if the user closes the casing of the mobile communication

terminal, as taught by Moriai, in the method of Tamaki, so that the content is delivered in its entirety without interruption.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tamaki (U.S. Patent Application Publication # 2005/0015285 A1)** in view of **Simpson et al. (U.S. Patent Application Publication # 2004/0039797 A1)**.

Consider **claim 7**, and **as applied to claim 1 above**, Tamaki shows and discloses the claimed method, including a content request sending step of sending, from the mobile communication terminal, a content request requesting a content usable by the mobile communication terminal to a content providing server apparatus which provides content via the communication network (Fig. 2 that shows and paragraph 0035 that describes a user terminal 216 (a wireless/cellular phone) which includes a miniature web browser used by the terminal user to specify a URL of a web site that includes an interface for accessing the contents 204; further disclosing that the user terminal 216 implements the access request via cellular network 212 and obtains the content from the contents delivery server 206 via public wireless LAN 214; paragraph 0036 which further discloses that the user terminal sends the request for the specific content via a GUI (Graphic User Interface) 500 to a reservation server 222 for download at a scheduled time that is most cost effective to the user); a content sending step of receiving, at the content providing server apparatus, the content request sent in the content request sending step (paragraphs 0036 and 0044

which teach that the reservation server (part of the content providing server apparatus) is configured to receive reservation request from the user terminal 216), and sending a content usable by the mobile communication terminal in response to the received content request, with the mobile communication terminal as a destination (Fig. 2 and paragraphs 0036 and 0044 which further show and disclose that the reservation server 222 is configured to determine an appropriate time for the download 220 of the requested content to the user terminal); and

a content receiving step of receiving, at the mobile communication terminal, the content sent in the content sending step (paragraph 0045 which discloses that the content delivery server 206 responds to the content request by performing content delivery 220 via the wireless LAN 214 to the user terminal 216, the user may then view or listen to the content; further disclosing that the user terminal is configured to perform a payment procedure with the reservation server 222 via the cellular network 212 after content delivery); and

wherein, in the information data set sending step the mobile communication terminal sends data indicating information relating to the content as the information data to the managing server apparatus via the communication network (paragraph 0058 which describes a user interface for collecting content reservation information from a user, including information relating to the content, such as selecting one of the top 3 movies for download and one of the top 10 music).

However, Tamaki does not specifically specify download of programs, although in the broadest interpretation of the term “content” by the examiner, programs can also be considered as content.

In the same field of endeavor, Simpson et al. discloses the claimed method, including downloading programs (Fig. 3; paragraph 0045-0046 which disclose that the web content 306 typically comprises text, graphics, and various commands; further stating that the commands can comprise one or more sets of executable instructions that are downloaded to the web browser 304 to perform a service requested by the user; Fig. 10 that shows and paragraph 107 that describes steps used in processing a content delivery request from a user that includes downloading executable programs).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include executable programs in processing content delivery requests from users, as taught by Simpson et al., in the method of Tamaki, so that the multimedia content as well as programs that play the multimedia content and appropriate licenses are delivered together to the user, who can then view or play the requested content.

Consider **claim 8**, and **as applied to claim 7 above**, Tamaki, as modified by Simpson et al., discloses the claimed method, further comprising:
an information data set transferring step of sending, from the managing server apparatus, the information data set received in the information data set storing step to the content providing server apparatus; and an information data set receiving step of

receiving, at the content providing server apparatus, the information data set sent in the information data set transferring step (in Tamaki reference, Fig. 12 which shows a delivery request 1218 from reservation server 222 (part of a managing server comprising servers 222, 602, and 604) to contents delivery server 206, the delivery request includes user-specified content and selected options 1204 (e.g. delivery time information), and network load information 1208; paragraphs 0072-0077 further disclose the same details); and
(in Simpson et al. reference, paragraph 0045 which discloses that the content request includes requests for executable programs as well).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Tamaki (U.S. Patent Application Publication # 2005/0015285 A1)** in view of **Simpson et al. (U.S. Patent Application Publication # 2004/0039797 A1)** and further in view of **Mori Masahito (Japanese Patent Application # JP 2002-123504, filed 04/25/2002, published 11/07/2003, applicants' supplied IDS)**.

Consider **claim 9**, and as applied to **claim 7 above**, Tamaki shows and discloses the claimed method, except further comprising:
a program stop request sending step of the managing server apparatus receiving the information data set indicating information relating to the program sent in the information data set sending step, reading data indicating conditions for stopping use of the program from the storage device, comparing the read data with information data set

indicating information relating to the program, generating and sending, to the mobile communication terminal, a program stop request to request stopping use of the program; and a program execution prohibiting step of the mobile communication terminal receiving the program stop request sent in the program stop request sending step, making use of the program by the user of the mobile communication terminal impossible.

In the same field of endeavor, Mori Masahito shows and discloses the claimed method, further comprising:

a program stop request sending step of the managing server apparatus receiving the information data set indicating information relating to the program sent in the information data set sending step, reading data indicating conditions for stopping use of the program from the storage device, comparing the read data with information data set indicating information relating to the program, generating and sending, to the mobile communication terminal, a program stop request to request stopping use of the program (page 6, paragraphs 0007-0008, and page 7, paragraphs 0017-0018 which disclose that a contents manager integrates a contents time (e.g. limiting the number of days the content may be used) when delivering the content, and when the offer term expires, automatically blocking further use of content by disabling the content); and a program execution prohibiting step of the mobile communication terminal receiving the program stop request sent in the program stop request sending step, making use of the program by the user of the mobile communication terminal impossible (page 10, lines 13-16 that describe a function which sends out the signal for displaying the message on

a monitoring device of a user terminal about playback refusal, and a function that automatically deletes the content after expiration of the offer's term; also paragraph 0026 on page 10 that discloses an information file for storing the information about the content and the terms of offer; pages 13-14, paragraphs 0038-0040 describe the same details).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a program stop request sending step of the managing server apparatus receiving the information data set indicating information relating to the program sent in the information data set sending step, reading data indicating conditions for stopping use of the program from the storage device, comparing the read data with information data set indicating information relating to the program, generating and sending, to the mobile communication terminal, a program stop request to request stopping use of the program, and a program execution prohibiting step of the mobile communication terminal receiving the program stop request sent in the program stop request sending step, making use of the program by the user of the mobile communication terminal impossible, as taught by Mori Masahito, in the method of Tamaki, as modified by Simpson et al., so as to provide automated control over the lease terms for the content requested by the client, and to prevent use of the content after the lease term has expired.

Conclusion

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Art Unit: 2443

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kishin G. Belani whose telephone number is (571) 270-1768. The Examiner can normally be reached on Monday-Friday from 6:00 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tonia Dollinger can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

*/K. G. B./
Examiner, Art Unit 2443*

October 16, 2009

*/George C Neurauter, Jr./
Primary Examiner, Art Unit 2443*